



AFR/DRU/29

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

ATTN: MAIL STOP AF

Satoshi EGAWA et al.

Group Art Unit: 2625

Examiner: M. RILEY

Filed: December 3, 2003

Docket No.: 117183

For: IMAGE FORMING DEVICE AND METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request is being filed with a Notice of Appeal and Petition for Extension of Time. Review of the March 3, 2010 Final Rejection is requested for the reasons set forth in the attached five or fewer sheets.

Should any questions arise regarding this submission, or the Review Panel believe that anything further would be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Kevin R. Davis
Registration No. 64,667

JAO:KRD/nlp

Attachment:

Notice of Appeal and Petition for Extension of Time

Date: July 6, 2010

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry of this filing; Charge any fee due to our Deposit Account No. 15-0461</p>
--

In reply to the March 3, 2010 Office Action, the June 8, 2010 Advisory Action, the June 18, 2010 Supplemental Advisory Action, the May 5, 2010 personal interview with Examiner Riley, and the June 8, 2010 telephone interview with Examiner Riley, reconsideration of the rejection is respectfully requested in light of the following remarks.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Riley in the June 8, 2010 telephone interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

Claims 1-39 are pending in this application. Claims 1-39 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Kurozasa (U.S. Patent No. 6,614,546) in view of Nakajima (U.S. Patent No. 7,305,620). Applicants respectfully traverse the rejection.

The Final Rejection and subsequent Advisory Actions commit clear error (1) by not fully considering the patentability of the dependent claims, and (2) by asserting that claims 1-39 are obvious in view of Kurozasa and Nakajima.

Applicants respectfully submit the following. In the June 8 Advisory Action, Examiner Riley failed to respond to the arguments presented in Applicants' May 27 Request for Reconsideration with respect to the dependent claims. Upon speaking with Examiner Riley in the June 8 telephone interview, the Examiner indicated that consideration of arguments with respect to the dependent claims was unnecessary in view of his determination of the alleged unpatentability of the independent claims. Examiner Riley confirms his view in the Interview Summary attached to the June 18 Supplemental Advisory Action, signed by Supervisory Patent Examiner Twyler L. Haskins, that "claims 2-14, 16-28, and 30-35 are not patentable by virtue of their dependencies on any of independent claims 1, 15, and 29."

Applicants respectfully submit, that by virtue of the dependent claims' compliance with 35 U.S.C. §112, paragraph 4, Examiner Riley's views on the nonpatentability of the dependent claims is in error. 35 U.S.C. §112, fourth paragraph requires that dependent claims

"specify a further limitation of the subject matter claimed." By virtue of this requirement, the dependent claims are narrower than the independent claims. The narrower dependent claims contain additional limitations and thus, their nonpatentability is not based on the nonpatentability of the independent claims.

Applicants respectfully submit that every limitation of the dependent claims has not been given full examination and consideration in view of Examiner Riley's incorrect interpretation of the law. However, Examiner Riley's rejections are addressed below.

Applicants respectfully submit that the applied references fail to disclose or render obvious, at least, an image forming device including a controller which enables editing of the printing data previously stored in the memory of the image forming device, as recited by claim 1, and similarly by claims 15, 29, and 36.

The Office Action relies on Fig. 9, and its corresponding description of Nakajima as allegedly curing the admitted deficiencies of Kurozasa with respect to this feature. While the Office Action points to Steps S104 and S105 of Nakajima, Applicants respectfully submit that the Office Action fails to take into consideration the surrounding disclosure.

Nakajima describes a print request is input (S100), the print request is converted to print control code (S102), and added-value information is inserted into the print control code (S103). The print control code (including the added-value information) is then stored in the spool file (S104). Once the editing instruction is received (S105), the data controller reads out the print code from the spool file and supplied it to the data edit controller (S106). The edit controller then performs editing as shown in Fig. 10 (S107).

The editing that is described in Fig. 10 only describes the editing of templates, color, density, position, and magnification, all of which are added-value information in the print control code. The edit controller of Nakajima does not edit the print request received at S100, nor does Nakajima disclose that the received print request (at S100) is stored in a memory.

Nakajima merely describes storing the print control code containing the added-value information and editing the added-value information contained in print control code.

Nakajima does not cure the deficiencies of Kurozasa as it does not disclose or render obvious a controller which enables editing of the printing data previously stored in the memory of the image forming device, as recited by claim 1, and similarly by claims 15, 29, and 36.

Applicants respectfully submit that the applied references fail to disclose or render obvious an image forming device wherein the controller enables editing of the printing data if the printing data satisfies a predetermined condition, as recited by claim 9, and similarly by claims 10, 23, 24, and 34. Specifically, the Office Action relies on steps S101-S111 of Fig 9, as well as col. 6, line 56 - col. 7, line 13 of Nakajima as allegedly curing the admitted deficiencies of Kurozasa with respect to these features.

Applicants respectfully submit that Nakajima does not describe any predetermined condition for satisfaction by the printing data as clearly seen by the above description of the process of Nakajima. At the personal interview, Examiner Riley clarified that the recitation of "if an edit instruction is input from, for example, the data input device 5" at col. 5, lines 63-64 of Nakajima can be interpreted as a predetermined condition.

However, Applicants respectfully submit that this does not describe a predetermined condition that is satisfied by the printing data. It merely describes that if an editing instruction is input, then editing is done. Conversely, if no editing instruction is input, then editing is not done. Nakajima does not describe an affirmative comparison of the print data with a predetermined condition such that it could enable or not enable editing based on the result of that comparison as required by claims 9, 10, 23, 24, and 34.

Nakajima does not cure the deficiencies of Kurozasa as it does not disclose or render obvious an image forming apparatus including wherein the controller enables editing of the

printing data if the printing data satisfies a predetermined condition, as recited by claim 9, and similarly by claims 10, 23, 24, and 34.

Applicants respectfully submit that the applied references fail to disclose or render obvious an image forming device wherein the controller enables editing of the printing data when an information processor which has transmitted the printing data is identical to an information processor which requests the editing of the printing data, as recited by claim 11, and similarly by claims 12, 25, 26, and 35. Specifically, the Office Action relies on steps S101-S111 of Fig 9, as well as col. 6, line 56 - col. 7, line 13 of Nakajima as allegedly curing the admitted deficiencies of Kurozasa with respect to these features.

Applicants respectfully submit that Nakajima does not describe an affirmative comparison between an information processor which has transmitted the printing data and an information processor which requests editing as clearly seen by the above description of the process of Nakajima. Nakajima does not describe any comparison of the print data input device that inputs the print request with the device which requests editing such that it could enable or not enable editing based on that comparison. As described above, it merely describes that if an editing instruction is input, then editing is done.

Nakajima does not cure the deficiencies of Kurozasa as it does not describe or render obvious an image forming apparatus wherein the controller enables editing of the printing data when an information processor which has transmitted the printing data is identical to an information processor which requests the editing of the printing data, as recited by claim 11, and similarly by claims 12, 25, 26, and 35.

Applicants respectfully submit that the applied references fail to disclose or render obvious an image forming device wherein the controller enables editing of the printing data when the user information added to the printing data is identical to user information input by a user who requests editing, as recited by claim 13, and similarly by claims 14, 27, and 28.

Specifically, the Office Action relies on steps S101-S111 of Fig 9, as well as col. 6, line 56 - col. 7, line 13 of Nakajima as allegedly curing the admitted deficiencies of Kurozasa with respect to these features.

Applicants respectfully submit that Nakajima does not describe an affirmative comparison between user information added to the printing data and user information input by a user who requests editing, as clearly seen by the above description of the process of Nakajima. Nakajima does not describe any comparison of user information added to the print request with user information input by a user who requests editing such that it could enable or not enable editing based on that comparison. As described above, it merely describes that if an editing instruction is input, then editing is done.

Nakajima does not cure the deficiencies of Kurozasa as it does not describe or render obvious an image forming apparatus wherein the controller enables editing of the printing data when the user information added to the printing data is identical to user information input by a user who requests editing, as recited by claim 13, and similarly by claims 14, 27, and 28.

Applicants respectfully submit that the applied references fail to disclose or render obvious each and every feature of, at least, claims 1, 9-15, 23-29, and 34-36. As such, claims 1, 9-15, 23-29, and 34-36 are patentable. Dependent claims 2-14, 16-28, and 30-35 are also patentable, at least for their dependencies on any of independent claims 1, 15, and 29, as well as for the additional features they recite.

Accordingly, Applicants respectfully request withdrawal of the rejection.